

REMARKS:

Claims 1-48 are currently pending in the application. Claims 1-11, 13, 15-25, 27, 29-39, 41, and 43-48 stand rejected under 35 U.S.C. § 102(b) over U.S. Patent No. 5,596,502 to Koski et al. ("*Koski*"). Claims 12, 26, and 40 stand rejected under 35 U.S.C. § 103(a) over *Koski* in view of the Examiners Official Notice. Claims 14, 28, and 42 stand rejected under 35 U.S.C. § 103(a) over *Koski* in view of U.S. Patent No. 5,991,728 to DeBusk et al. ("*DeBusk*").

Although the Applicants believe that claims 1-48 are directed to patentable subject matter and are in condition for allowance without amendment. The Applicants have canceled claims 2, 4, 16, 18, 30, and 32, without prejudice. The Applicants have also amended independent claims 1, 15, and 29 and dependent claims 3, 12, 17, and 31 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully denies any statement or averment of the Examiner not specifically addressed. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed claims 1-48. No new matter has been added.

The Applicants respectfully request the Examiner to withdraw the finality of the Final Office Action dated 4 January 2006, as the finality of the Office Action is improper under MPEP § 2144.03(D). The Applicants respectfully request the Examiner to call the undersigned at (817) 447-9955 if there are any questions regarding the finality of the Final Office Action dated 4 January 2006 or if the Examiner believes that it would be easier to discuss the finality of the Final Office Action dated 4 January 2006 over the telephone.

REJECTION UNDER 35 U.S.C. § 102(b):

Claims 1-11, 13, 15-25, 27, 29-39, 41, and 43-48 stand rejected under 35 U.S.C. § 102(b) over *Koski*.

Although the Applicants believe claims 1-48 are directed to patentable subject matter, and in condition for allowance without amendment. The Applicants have canceled claims 2, 4, 16, 18, 30, and 32, without prejudice. The Applicants have also amended independent claims 1, 15, and 29 and dependent claims 3, 12, 17, and 31 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 102(b), as set forth in the Office Action.

The Applicants respectfully submit that ***the amendments to independent claims 1, 15, and 29 have rendered moot the Examiner's rejection of claims 1-11, 13, 15-25, 27, 29-39, 41, and 43-48 and the Examiner's arguments in support of the rejection of claims 1-11, 13, 15-25, 27, 29-39, 41, and 43-48.*** The Applicants further submit that amended independent claims 1, 15, and 29 in their current amended form contain unique and novel limitations that are not disclosed, suggested, or even hinted at in *Koski*. Thus, the Applicants respectfully submit that amended independent claims 1, 15, and 29 patentably distinguish over *Koski* and dependent claims 2, 3, 5-14, 16, 17, 19-28, 30, 31, and 33-42, which depend from amended independent claims 1, 15, and 29, likewise patentably distinguish over *Koski*.

Koski Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to independent claim 1, this claim recites:

A method for ***resource capacity collaboration***, comprising:
accessing an assignment of an item used in producing a product for a customer to a first resource of a factory, associated with a supplier, in a first production period;
accessing a capacity value representing a capacity of the first resource to process one or more items in the first production period;
accessing a demand value representing a demand placed on the first resource in the first production period by the assignment of the item to the first resource;
if a demand-capacity mismatch exists with respect to the first resource in that the demand value exceeds the capacity value,

automatically **generating a notification of the demand-capacity mismatch**, automatically communicating the notification to a user associated with the customer, and **allowing the user associated with the customer to reassign at least a portion of the demand** placed on the first resource in the first production period to at least one of a **second resource** and a second production period;

if the demand-capacity mismatch cannot be fully resolved as a result of reassignment of at least a portion of the demand placed on the first resource of the factory to at least one of a second resource of the same factory, **allowing the user associated with the customer to reassign at least a portion of the demand to another factory** to attempt to resolve the demand-capacity mismatch; and

if the demand-capacity mismatch cannot be fully resolved as a result of reassignment of at least a portion of the demand placed on the second resource of the factory to another factory, **allowing the user associated with the customer to reassign at least a portion of the demand to another supplier** to attempt to resolve the demand-capacity mismatch. (Emphasis Added).

Independent claims 15, 29, and 43-48 recite similar limitations. *Koski* fails to disclose each and every limitation of independent claims 1, 15, 29, and 43-48.

The Applicants respectfully maintains that *Koski* has nothing to do with independent claim 1 limitations regarding a **"resource capacity collaboration"**. Rather *Koski* discloses a closed-loop computerized management system for allocation of resources at a workspace at a specified future date and time. (Column 1, Lines 19-27 and Column 5, Lines 17-18). ***Koski merely describes a system in which the customer lacks visibility into the supply chain, meaning that the customer in Koski is completely unaware of how production is proceeding through this closed-loop system.*** In addition, the customer in *Koski* is outside of the closed-loop system, with the exception of ordering and receiving the entire demand of the product. (Column 12, Lines 51-55). *Koski* does not disclose, teach, or suggest that the closed-loop computerized management system in *Koski* provides for any input to the customer or even any visibility to the customer. Thus, ***Koski teaches away from the claimed invention***, because the customer is *Koski* lacks any visibility in the supply chain and knows only that the product order has been accepted and when to expect delivery.

The Applicants further maintain that *Koski* does not disclose “**accessing an assignment of an item used in producing a product for a customer to a first resource of a factory, associated with a supplier, in a first production period**”. Rather *Koski* merely discloses the reception of an order that is broken down into a set of features of the functionalities desired by the customer. (Column 12, Lines 5-9). *Koski* does not suggest, teach, or even hint at the **assignment of an item used in producing a product for a customer**. Thus, *Koski* cannot provide **accessing an assignment of an item used in producing a product for a customer to a first resource of a factory, associated with a supplier, in a first production period**, since *Koski* fails to disclose the assignment of any items or resources used in producing the product in the first place.

The Applicants still further maintain that *Koski* does not disclose **accessing a capacity value representing a capacity of the first resource to process one or more items in the first production period**. Rather, *Koski* describes an approach to select a particular workspace on a shop floor that will provide the set of features of the functionalities desired by the customer. (Column 12, Lines 24-27). This approach, in *Koski*, **merely allows the manufacturer, not the customer**, to select an appropriate path for the workspace along a particular shop floor. *Koski* does not suggest, teach, or even hint at the selection of a workspace is in anyway associated with the capacity value associated with the capacity of each resource in connection with the production of a product for the customer. Thus, *Koski* cannot provide **accessing a capacity value representing a capacity of the first resource to process one or more items in the first production period**, since *Koski* does not even provide for the assessment of the capacity value in the first place.

The Applicants still further maintain that *Koski* does not disclose **accessing a demand value representing a demand placed on the first resource in the first production period by the assignment of the item to the first resource**. Rather, *Koski* discloses a determination of features to be supplied. (Column 12, Lines 16-19). *Koski* does not suggest, teach, or even hint at **accessing a demand value** that is in anyway associated with the demand that is currently placed on each resource in connection with production of a product for a customer. Thus, *Koski* cannot provide

accessing a demand value representing a demand placed on the first resource in the first production period by the assignment of the item to the first resource, since *Koski* does not even contemplate identifying a demand value in the first place.

The Applicants respectfully submit that *Koski* does not disclose ***if a demand-capacity mismatch exists with respect to the first resource in that the demand value exceeds the capacity value,*** automatically ***generating a notification*** of the demand-capacity mismatch, automatically ***communicating the notification*** to a user associated with the customer, and ***allowing the user associated with the customer to reassign at least a portion of the demand*** placed on the first resource in the first production period to at least one of ***a second resource*** and a second production period. Rather, *Koski* ***describes a unilateral response sent to the customer.*** (Column 12, Lines 53-55). The Applicants direct the Examiner's attention to the cited portions of *Koski*, relied upon by the Examiner:

If sufficient resources do not exist to meet the customer's demand, a rich response ***explaining the resource shortfall*** as well as a best-can-do production figure of the requested delivery time and ***a time frame to meet the entire demand is related back to the customer*** at 62. (Column 12, Lines 53-55). (Emphasis Added).

Although, *Koski*, discloses a response sent to the customer, ***this response is a unilateral response which merely advises the customer of a new delivery date or time frame to meet the entire demand of the customer.*** The customer in *Koski* lacks any visibility into the supply chain planning problem and is further unable to participate in any resolution of the capacity problem. In contrast, the customer recited in amended independent claim 1 is an active participant in the resolution of any supply chain capacity problems.

In addition, *Koski* does not suggest, teach, or even hint at an automatic notification triggered by the demand value exceeding the capacity value that does anything more than merely notifies the customer, or the reassignment of the demand on another resource in connection with production of a product for the customer. Thus, *Koski* cannot provide ***if a demand-capacity mismatch exists with respect to the first resource in that the***

demand value exceeds the capacity value, automatically generating a notification of the demand-capacity mismatch, automatically communicating the notification to a user associated with the customer to reassign at least a portion of the demand placed on the first resource in the first production period to at least one of a second resource and a second production period, since Koski does not even contemplate allowing the customer to reassign demand.

The Applicants further submit that *Koski* does not disclose ***“if the demand-capacity mismatch cannot be fully resolved as a result of reassignment*** of at least a portion of the demand placed on the first resource of the factory to at least one of a second resource of the same factory, ***allowing the user associated with the customer to reassign at least a portion of the demand to another factory*** to attempt to resolve the demand-capacity mismatch”. The Applicants still further submit that *Koski* does not disclose ***“if the demand-capacity mismatch cannot be fully resolved as a result of reassignment*** of at least a portion of the demand placed on the second resource of the factory to another factory, ***allowing the user associated with the customer to reassign at least a portion of the demand to another supplier*** to attempt to resolve the demand-capacity mismatch.”

As mentioned above, *Koski* discloses a closed-loop system for allocation of resources at a workspace at a specified future date and time. (Column 1, Lines 19-27 and Column 5, Lines 17-18). ***The closed-loop system of Koski does not allow the customer to interact with any capacity problems associated with a demand-capacity mismatch at a resource, factory, or even at a supplier.*** In addition, the customer in *Koski* is outside of the closed-loop system, meaning that the customer is not capable, able, or otherwise allowed to effect the use of resources in *Koski*. Thus, ***Koski teaches away from the claimed invention***, because the customer is *Koski* lacks any ability to participate in the resolution of capacity problems.

The Applicants Claims are Patentable over *Koski*

The Applicants respectfully submit that the allegation in the present Office Action that *Koski* discloses all of the claimed features is respectfully traversed. Further, it is noted

that the Office Action provides no concise explanation as to how *Koski* is considered to anticipate all of the limitations in amended independent claim 1. ***A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if each and every element of a claimed invention is identically shown in that single reference.*** MPEP § 2131. The Applicants respectfully point out that "***it is incumbent upon the [E]xaminer to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.***" Ex parte Levy, 17 U.S.P.Q.2d (BNA) 1461, 1462 (Pat. & Tm. Off. Bd. Pat. App. & Int. 1990). The Applicants respectfully submit that the Office Action has failed to establish a prima facie case of anticipation in amended independent claim 1 under 35 U.S.C. § 102 with respect to *Koski* because *Koski* fails to identically disclose each and every element of the Applicants claimed invention, arranged as they are in Applicants claim.

The Applicants respectfully submit that independent claims 15, 29, and 43-48 includes limitations similar to those discussed above in connection with amended independent claim 1. Thus, independent claims 15, 29, and 43-48 are considered patentably distinguishable over *Koski* for at least the reasons discussed above in connection with amended independent claim 1. Furthermore, with respect to dependent claims 2, 3, 5-14, 16, 17, 19-28, 30, 31, and 33-42: dependent claims 2, 3, and 5-14 depend from amended independent claim 1; dependent claims 16, 17, and 19-28 depend from amended independent claim 15; and dependent claims 30, 31, and 33-42 depend from amended independent claim 29. As mentioned above, each of independent claims 1, 15, 29, and 43-48 are considered patentably distinguishable over *Koski*. Thus, dependent claims 2, 3, 5-14, 16, 17, 19-28, 30, 31, and 33-42 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

Thus, for at least the reasons set forth herein, the Applicants submit that claims 1-3, 5-11, 13, 15-17, 19-25, 27, 29-31, 33-39, 41, and 43-48 are not anticipated by *Koski*. The Applicants further submit that claims 1-3, 5-11, 13, 15-17, 19-25, 27, 29-31, 33-39, 41, and 43-48 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1-3, 5-11, 13, 15-17, 19-25, 27, 29-31, 33-39, 41, and 43-48 under 35

U.S.C. § 102(b) be reconsidered and that claims 1-3, 5-11, 13, 15-17, 19-25, 27, 29-31, 33-39, 41, and 43-48 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.
6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.
7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the Claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 12, 26, and 40 stand rejected under 35 U.S.C. § 103(a) over *Koski* in view of the Examiners Official Notice. Claims 14, 28, and 42 stand rejected under 35 U.S.C. § 103(a) over *Koski* in view of *DeBusk*.

Although the Applicants believe claims 1-48 are directed to patentable subject matter, and in condition for allowance without amendment. The Applicants have canceled claims 2, 4, 16, 18, 30, and 32, without prejudice. The Applicants have also amended independent claims 1, 15, and 29 and dependent claims 3, 12, 17, and 31 to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Proposed *Koski-Official-Notice* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Dependent Claims 12, 26, and 40

The Applicants respectfully maintain that *Koski* or the Examiners Official Notice, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 12, 26, and 40. Thus, the Applicants respectfully maintain the traverse of the Examiner's obvious rejection of dependent claims 12, 26, and 40 under 35 U.S.C. § 103(a) over the proposed combination of *Koski* and the Examiners Official Notice, either individually or in combination.

For example, with respect to dependent claim 12, this claim recites:

The method of Claim 1, further comprising:
storing at least one access privilege; and
making the assignment, the capacity value, the demand value, and the notification available to a user associated with at least one of the customer, the factory, and the supplier based on the access privilege. (Emphasis Added).

Dependent claims 26 and 40 recite similar limitations. *Koski* or the Examiners Official Notice, either individually or in combination, fail to disclose, teach, or suggest each and every limitation of dependent claims 12, 26, and 40.

The Applicants respectfully maintain that the Office Action acknowledges, and Applicants agree, that *Koski* fails to disclose the emphasized limitations noted above in dependent claim 12. Specifically the Examiner acknowledges that *Koski* fails to disclose “storing at least one access privilege and ***making the assignment, the capacity value, the demand value, and the notification available to a user associated with*** at least one of ***the customer, the factory, and the supplier based on the access privilege.***” (4 January 2006 Office Action, Page 16). However, the Examiner asserts Official Notice over the acknowledged shortcomings in *Koski*. The Applicants respectfully maintain the traverse of the Examiners assertions regarding the Official Notice taken by the Examiner.

The Applicants respectfully maintain that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Koski* and the Examiners Official Notice, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Koski* and the Examiners Official Notice as proposed. The Office Action merely states that it would have been “obvious to one of ordinary skill in the art at the time of the invention to modify *Koski* regarding providing resource capacity and demand allocation on a computer network, to include the step of providing security access to said network”. (4 January 2006 Office Action, Page 17). The Applicants respectfully disagree. In particular, the Examiner equates the Examiner’s Official Notice of “providing security access to said network” with “***storing at least one access privilege***” as recited in dependent claim 12. (4 January 2006 Office Action, Page 17). However, the step of “providing security access to said network” in the Examiners Official Notice is only one element recited in dependent claim 12. In contrast, dependent claim 12 recites “storing at least one access privilege and ***making the assignment, the capacity value, the demand value, and the notification available to a user associated with*** at least one of

the customer, the factory, and the supplier based on the access privilege." Thus, the Applicants respectfully submit that ***the equations forming the foundation of the Examiner's comparison between the Examiners Official Notice and dependent claim 12 cannot be made.*** The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish dependent claim 12 from the Examiner's Official Notice.

The Applicants further maintain that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Koski* or the Examiners Official Notice, either individually or in combination. The Examiner asserts that one of ordinary skill in the art at the time of the invention would have been motivated to modify *Koski* and the Examiners Official Notice "because it would ensure that users who want to access the system have the proper clearance." (4 January 2006 Office Action, Page 17). The Applicants respectfully disagree. The Applicants respectfully maintain the request for the Examiner to point to the portions of *Koski* or the Examiners Official Notice which contain the teaching, suggestion, or motivation to combine *Koski* and the Examiners Official Notice for the Examiners stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Koski and the Examiners Official Notice to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statements that it would have been obvious "to modify the teachings of *Koski*, regarding providing resource capacity and demand allocation on a computer network, to include the step of providing security access to said network" and that "it would ensure that users who want to access

the system have the proper clearance" ***does not adequately address the issue of motivation to combine***. (4 January 2006 Office Action, Page 17). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Koski or the Examiners Official Notice***, either individually or in combination.

The Examiner's Official-Notice is improper under MPEP § 2144.03

The Applicants respectfully maintain that the Applicants are confused as to what the Examiner teaches by the Official Notice or even the extent in which the Examiner is taking Official Notice, as related to the subject Application and in particular to the limitations as recited in dependent claim 12. In response to the Applicants request for clarification as to the subject matter for which the Examiner is taking Official Notice, the Examiner asserts "the concept of storing an access privilege and making access contingent on that privilege is old and well known in the art of computer security." (4 January 2006 Office Action, Page 5). The Examiner further recites the definition of a password from the Dictionary of Computers. (4 January 2006 Office Action, Page 5).

The Applicants respectfully traverse the Official Notice because the asserted facts, as best understood by the Applicants, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. In addition, the Applicants respectfully submit that the Examiner's clarification of the Examiner's Official Notice has nothing to do with the limitations recited in dependent claim 12 of "storing at least one access privilege and ***making the assignment, the capacity value, the demand value, and the notification available to a user associated with*** at least one of ***the customer, the factory, and the supplier based on the access privilege***." Thus, even if the Examiner's Official Notice was proper, which it is

not, the Applicants dependent claim 12 is patentably distinguished from the Examiner's Official Notice.

Additionally, the Examiner asserts that "the presentation of a reference to substantiate the Official Notice is not deemed necessary" because the Applicants have "not provided adequate information or argument so that ***on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice.***" (4 January 2006 Office Action, Page 5). The Applicants respectfully disagree. The Applicants are confused as to where the Examiner has derived this "***reasonable doubt***" test and respectfully requests further explanation from the Examiner. The Applicants respectfully disagree with this "***reasonable doubt***" test and request the Examiner to cite a specific rule in 37 C.F.R. or in the MPEP which provides for this "***reasonable doubt***" test. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). The Applicants respectfully request the Examiner to produce authority for the Examiners Official Notice.

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art ***are capable of instant and unquestionable demonstration as being well-known.*** As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in

the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP § 2144.03(B)). (Emphasis Added).

The Applicants respectfully maintain that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of "instant and unquestionable" demonstration as being well-known. The Applicants further maintain that ***the Applicants have adequately traversed the Examiners assertion of Official Notice*** and direct the Examiner's attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of claims 12, 26, and 40 based on the Examiners Official Notice, the Applicants respectfully request that the Examiner provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicants further request that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

In addition, the Applicants respectfully point the Examiner to the pertinent sections of the MPEP, directly on point to determine whether the next Office Action should be made Final. In particular, the Applicants respectfully direct the Examiner's attention to MPEP § 2144.03(D), which states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. (MPEP § 2144.03(D)).

The Proposed *Koski-DeBusk* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Dependent Claims 14, 28, and 42

The Applicants respectfully maintain that *Koski* or *DeBusk*, either individually or in combination, fail to disclose, teach, or suggest each and every element of dependent claims 14, 28, and 42. Thus, the Applicants respectfully maintain the traverse of the Examiner's obvious rejection of dependent claims 14, 28, and 42 under 35 U.S.C. § 103(a) over the proposed combination of *Koski* and *DeBusk*, either individually or in combination.

For example, with respect to dependent claim 14, this claim recites:

The method of Claim 13, further comprising ***providing a tree structure to the user in a display***, the tree structure ***comprising the first resource, the additional resource, and*** at least the ***demand values for the first resource and additional resource***. (Emphasis Added).

Dependent claims 28 and 42 recite similar limitations. *Koski* or *DeBusk*, either individually or in combination, fail to disclose, teach, or suggest each and every limitation of dependent claims 14, 28, and 42.

The Applicants respectfully maintain that the Office Action acknowledges, and Applicants agree, that *Koski* fails to disclose the emphasized limitations noted above in dependent claim 14. Specifically the Examiner acknowledges that *DeBusk* fails to disclose “providing a tree structure to the user in a display, the tree structure comprising the first resource, the additional resource, and at least the demand values for the first resource and additional resource.” (4 January 2006 Office Action, Pages 17-18). However, the Examiner asserts that the cited portions of *DeBusk* disclose the acknowledged shortcomings in *Koski*. The Applicants respectfully maintain the traverse of the Examiner's assertions regarding the subject matter disclosed in *DeBusk*.

The Applicants have reviewed *DeBusk* in detail, particularly looking for a resource capacity collaboration, relied upon by the Examiner. (4 January 2006 Office Action, Pages 17-18). However, *DeBusk* fails to disclose, teach or suggest several of the limitations recited by dependent claim 14. Thus, the Applicants respectfully maintain the traverse of the Examiner's assertions regarding the subject matter disclosed in *DeBusk*.

The Applicants respectfully maintain that *DeBusk* has nothing to do with the dependent claim 14 limitations regarding a “***resource capacity collaboration***” and in particular *DeBusk* has nothing to do with dependent claim 14, 28, or 42 limitations regarding “***providing a tree structure to the user in a display***, the tree structure ***comprising the first resource, the additional resource, and*** at least the ***demand values for the first resource and additional resource***.” Rather, *DeBusk* describes a method for tracking medical supply usage on a procedure level in a clinical setting. (Abstract). *DeBusk* does not disclose, teach, or suggest at least one additional resource

associated with the factory operable to receive and process a second item from the first resource and further providing a tree structure to the user in a display. Thus *DeBusk* cannot provide a tree structure to the user in a display, the tree structure comprising the first resource, the additional resource, and at least the demand values for the first resource and additional resource, since *DeBusk* does not even provide for an additional resource associated with the factory in the first place.

The Applicants respectfully maintain that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Koski* and *DeBusk*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine *Koski* and *DeBusk* as proposed. The Office Action merely states that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Koski*, regarding providing resource and capacity planning to include the step of providing a tree structure containing resource demands to allocate resources in a standardized way to fulfill customer orders. (4 January 2006 Office Action, Page 18). The Applicants respectfully disagree.

The Applicants further maintain that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Koski* or *DeBusk*, either individually or in combination. The Examiner asserts that one of ordinary skill in the art at the time of the invention would have been motivated to modify *Koski* and *DeBusk* because it would result in standardization of resource groupings to lower inventory carrying costs. (4 January 2006 Office Action, Page 18). The Applicants respectfully disagree. The Applicants respectfully request the Examiner to point to the portions of *Koski* or *DeBusk* which contain the teaching, suggestion, or motivation to combine *Koski* and *DeBusk* for the Examiners stated purported advantage. The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, the Examiner has not adequately supported the selection and combination of *Koski* and *DeBusk* to render obvious the Applicant's claimed invention. The Examiner's conclusory statements that it would have been obvious "to modify *Koski*, regarding providing resource and capacity planning to include the step of providing a tree structure containing resource demands to allocate resources in a standardized way to fulfill customer orders" and that "it would result in standardization of resource groupings to lower inventory carrying costs" does not adequately address the issue of motivation to combine. (4 January 2006 Office Action, Page 18). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Koski* or *DeBusk*, either individually or in combination.

The Applicants Claims are Patentable over the Proposed *Koski-DeBusk* Combination

With respect to dependent claims 12, 14, 26, 28, 40, and 42: claims 12 and 14 depend from independent claim 1; claims 26 and 28 depend from independent claim 15; and claims 40 and 42 depend from independent claim 29. As mentioned above, each of independent claims 1, 15, and 29 are considered patentably distinguishable over the proposed combination of *Koski*, *DeBusk*, or the Examiners Official Notice, either individually or in combination. Thus, dependent claims 12, 14, 26, 28, 40, and 42 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that claims 12, 14, 26, 28, 40, and 42 are not rendered obvious by the proposed combination of *Koski*, *Debusk*, or the Examiners Official Notice. The Applicants further submit that claims 12, 14, 26, 28, 40, and 42 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 12, 14, 26, 28, 40, and 42 under 35 U.S.C. § 103(a) be reconsidered and that claims 12, 14, 26, 28, 40, and 42 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation***, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure***. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have

suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

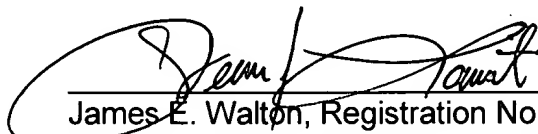
In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicants believe no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

2/14/06
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